

Remarks

This Application has been carefully reviewed in light of the Office Action mailed March 4, 2004. Although Applicant believes all pending claims are allowable over the prior art of record without amendment, to expedite issuance Applicant has made clarifying amendments to Claims 1, 15, 28, 30, 44, and 57. None of these amendments are considered necessary for patentability. Applicants respectfully provide these remarks and request reconsideration and favorable action in this case.

The Examiner rejects Claims 1-57 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,598,219 issued to Lau ("Lau") in view of U.S. Patent Publication No. US 2002/0129345 A1 to Tilden et al. ("Tilden").

Applicants respectfully disagree for at least two reasons. First, even if *Lau* and *Tilden* could be properly combined, the proposed combination would still fail to disclose, teach, or suggest each and every element recited in the rejected claims. Second, the required teaching, suggestion, or motivation to combine *Lau* and *Tilden* is lacking, such that the proposed combination is improper.

**The Proposed Combination of References Fails to Meet
Limitations Recited in Applicants' Claims**

First, even assuming for the sake of argument that *Lau* and *Tilden* could be properly combined, which Applicants dispute, the proposed *Lau-Tilden* combination would still fail to disclose, teach, or suggest each and every limitation specifically recited in the rejected claims. Applicants discuss independent Claim 1 as an example.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art

reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143.

At a minimum, as the Examiner acknowledges, *Lau* fails to disclose, teach, or suggest "*a rules manager operable to manage rules that specify logic for the handling of notifications associated with XML-based action documents received at the application, the notifications requesting actions involving data documents*" as recited in Claim 1 as originally filed. Furthermore, *Lau* fails to disclose, teach, or suggest "*the action documents defining notifications supported by one or more applications developed using the framework*" as recited in Claim 1 as amended. *Lau* certainly fails to disclose, teach, or suggest "*a rules manager operable to manage rules that specify logic for the handling of notifications associated with XML-based action documents received at the application, the action documents defining notifications supported by one or more applications developed using the framework, the notifications defined by the action documents requesting actions involving data documents*" as recited in Claim 1 as amended.

Tilden fails to remedy these deficiencies of *Lau*. Applicants respectfully note that the Examiner has not specifically pointed out which elements of *Tilden* the Examiner believes correspond to the "rules manager" recited in Claim 1. In any event, Applicants respectfully submit that *Tilden* fails to disclose "*a rules manager operable to manage rules that specify logic for the handling of notifications associated with XML-based action documents received at the application, the action documents defining notifications supported by one or more applications developed using the framework, the notifications defined by the action documents requesting actions involving data documents*" as recited in Claim 1. The cited portion of *Tilden* indicates only that *Tilden* includes a Rules Engine "which is operable to read a predetermined rule set (not shown) from session state document 706." *Tilden*, page 4, ¶ 50. With respect to the Rules Engine, *Tilden* states that "Rules Engine 702 retrieves a script (not shown) from session state document 706." *Tilden*, page 4, ¶ 50. *Tilden* further notes that "the script includes one or more rule sets, as described below, for controlling the behavior of component 700." *Tilden*, page 4, ¶ 50- page 5, ¶ 50. Nowhere in the cited portion or any other portion of *Tilden*, however, does *Tilden* disclose "*action documents*

defining notifications supported by one or more applications developed using the framework” as recited in Claim 1 as amended. Nor does *Tilden* disclose “*a rules manager operable to manage rules that specify logic for the handling of notifications associated with XML-based action documents*” as recited in Claim 1 as originally filed. *Tilden* certainly fails to disclose, teach, or suggest “*a rules manager operable to manage rules that specify logic for the handling of notifications associated with XML-based action documents received at the application, the action documents defining notifications supported by one or more applications developed using the framework, the notifications defined by the action documents requesting actions involving data documents*” as recited in Claim 1 as amended. This is true even if *Tilden* is considered in combination with *Lau*.

Thus, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest at least these limitations recited in Claim 1.

The proposed *Lau-Tilden* combination also fails to disclose, teach, or suggest a “*framework providing a generic XML-based transaction engine, the application being one of a plurality of distributed applications, each being an instance of the generic transaction engine*” as recited in Claim 1 as originally filed and as amended. While the Examiner correctly chooses not to allege that *Tilden* discloses these elements, the Examiner does assert that *Lau* discloses “*a generic XML-based transaction engine, the application being one of a plurality of distributed applications, each being an instance of the generic transaction engine*.” Applicants respectfully note that the Examiner again has not specifically pointed out which elements of *Lau* the Examiner believes correspond to these elements of Claim 1. In any event, Applicants respectfully submit that *Lau*, in fact, fails to disclose any “*generic XML-based transaction engine*” or “*a plurality of distributed applications each being an instance of the generic transaction engine*” as recited in Claim 1. The cited portions of *Lau* discuss the contents of a data model, noting that “[t]he data content of the object, i.e. instance of data, is expressed by the object builder tool in the form of a text document.” Thus, the cited portions of *Lau* merely disclose instances of data, not “*instance[s] of the generic transaction engine*” as recited in Claim 1. Furthermore, to whatever extent the Examiner may be alleging that “the object builder tool” disclosed in *Lau* represents an application, the

disclosed object builder tool does not represent a “*plurality of distributed applications each being an instance of the generic transaction engine*” as recited in Claim 1. *Tilden* fails to make up for these deficiencies of *Lau*.

Thus, the proposed *Lau-Tilden* combination also fails to disclose, teach, or suggest at least these limitations recited in Claim 1.

The Proposed Combination of References is Improper

Second, these rejections are improper at least because the Examiner has not shown the required teaching, suggestion, or motivation in *Lau*, *Tilden*, or knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Lau* with *Tilden* in the manner the Examiner proposes. The rejected claims are also allowable for at least this reason.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

As noted above, to establish a *prima facie* case of obviousness based on modification or combination of prior art, the Examiner must identify some teaching, suggestion, or motivation to make the proposed modification or combination. The teaching, suggestion, or motivation for the modification or combination must be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available

to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. M.P.E.P. § 2143.01, citations omitted. Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

modification or combination is not sufficient to establish a *prima facie* case of obviousness. See *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the examiner to show a motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id*; *See also*, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

Nothing in *Lau*, *Tilden*, or knowledge generally available to those of ordinary skill in the art at the time of the invention teaches, suggests, or motivates in any way the proposed combination. *Lau* discloses a data model containing meta-data that is expressed using an open standard language. *Lau*, column 2, lines 23-34. *Tilden* discloses a “three-tiered e-commerce architecture with CORBA providing [a] distribution mechanism” for implementing business logic. *Tilden*, page 2, ¶ 27. Neither reference provides any indication that benefits may be gained by adding features disclosed by the other reference. Moreover, the Examiner has provided no explanation as to why one of ordinary skill in the art at the time the invention was made would have been motivated to combine the references in the manner the Examiner proposes.²

With regard to the proposed *Lau-Tilden* combination, the Examiner indicates that “Tilden et al disclose a rule manager operable to manager [sic] rules that specify logic for the handling of notifications associated with XML based action documents received at the application” and that “[t]herefore, it would have been obvious to one having ordinary skill in the art to incorporate the teaching of Tilden et al into the teaching of Lau to have a rule manager operable to manager [sic] rules that specify logic for the handling of notifications associated with XML based action documents received at the application . . . because one would want to utilize the rule set to allow customization of the behavior of the associated component of the software system.” *Office Action*, page 3. Applicants respectfully note that the Examiner appears to focus solely on the fact that the two references may both, in certain embodiments, utilize XML. This fact does not, however, provide a sufficient teaching, suggestion, or motivation for proper combination of these disparate references. The Examiner's speculation that "it would have been obvious" to one of ordinary skill in the art at the time of the invention to combine the teachings of *Lau* with *Tilden* to achieve Applicants' invention, in hindsight with the benefit of Applicants' claims as a roadmap for selecting

² If "common knowledge" or "well known" art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

portions of the two references, is clearly insufficient under the M.P.E.P. and governing Federal Circuit case law.

Furthermore, the subject matter of the two references teaches away from the proposed combination. *Tilden* states that “a central theme of the present invention is to implement a middleware framework that greatly simplifies a deployment of business objects 116 *without exposing the system source code.*” *Tilden*, page 2, ¶ 28, emphasis added. By contrast, *Lau* stresses that representing the meta data using an open standard is advantageous primarily because “conventional parsers for the open standard may be used to retrieve the meta-data.” *Lau*, column 2, lines 31-35. Thus, the contrasting benefits of *Tilden* and *Lau* strongly teach away from the proposed combination. *See* M.P.E.P. § 2143.01. Additionally, because *Tilden* seeks to operate without exposing system source code while *Lau* is designed to improve accessibility, the proposed combination would improperly change the principle of operation of both *Tilden* and *Lau*. *See* M.P.E.P. § 2143.01. As a result, even putting aside the issue of whether the combination of *Lau* and *Tilden* discloses, teaches, or suggests each and every element of the claimed invention, the inability to properly combine *Lau* with *Tilden* is fatal to these rejections.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Lau* and *Tilden* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner’s conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

Thus, *Lau* and *Tilden*, both alone and in combination, fail to disclose, teach, or suggest every element of Claim 1. Additionally, the proposed combination of *Lau* and *Tilden* is improper. For at least these reasons, Claim 1 is allowable. Applicant respectfully requests reconsideration and allowance of Claim 1 and its dependent claims. Although of differing scope from Claim 1 and from one another, independent Claims 15, 28, 30, 44, and 57 are allowable for at least substantially similar reasons. Applicants respectfully request reconsideration and allowance of Claims 15, 28, 30, 44, and 57 and their dependent claims.

Several Dependent Claims are Allowable for Additional Reasons

Additionally, many of the claims depending on Claim 1 include other limitations that are also not disclosed, taught, or suggested in the cited references and are allowable for at least this additional reason.

As one example, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest “*the application operable to access the data document using an address specified during deployment of the application, the application operable to determine the address for the data document substantially on the fly during operation of the application*” as recited in dependent Claim 3. As the Examiner correctly concedes, *Lau* does not disclose these limitations. *Office Action*, page 4. The Examiner asserts that *Tilden* discloses these limitations, but again has not specifically pointed out which elements of *Tilden* the Examiner believes correspond to “*an application . . . operable to determine the address for the data document substantially on the fly during operation of the application*” as recited in Claim 3. In any event, the cited portion of *Tilden*, in fact, fails to disclose, teach, or suggest these limitations. The cited portion of *Tilden* indicates only that the disclosed server supports three different threading models. *Tilden*, page 3, ¶ 33. *Tilden* further notes that “[t]he threading model used is specified by the configuration file. However, it can also be changed at run time.” *Tilden*, page 3, ¶ 36. Thus, *Tilden* merely discloses determining a threading model at run time, not an address for a data document. The cited portion of *Tilden* also discloses the contents of a configuration file that include a component named “CityCodeStrictLookup” that specifies “a creator name” and “a location of the creator, i.e., a library.” *Tilden*, page 3, ¶ 40. Even assuming for the sake of argument that the specified library represented an address of a data document, *Tilden* still would not disclose determining the library “*substantially on the fly*” as recited in Claim 3.

Thus, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest each and every limitation recited in dependent Claim 3. For at least substantially similar reasons, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest each and every limitation recited in dependent Claims 17, 32, and 46. As a result, even if the Examiner

maintains the rejections of the independent claims in spite of the above remarks, Applicants respectfully submit that dependent Claims 3, 17, 32, and 46 are plainly allowable over the proposed *Lau-Tilden* combination. Applicants respectfully request reconsideration and allowance of dependent Claims 3, 17, 32, and 46.

As another example, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest “*each operation is packaged in an XML-based request*” and “*the request comprises at least one parent data document and one or more child data documents*” as recited in dependent Claim 8. The portion of *Lau* cited by the Examiner indicates only that the disclosed device recognizes inheritance. *Lau*, column 5, lines 8-9. The cited portion does not discuss any form of requests or the content of any such requests. Thus, the cited portion does not disclose, teach, or suggest that “*each operation is packaged in an XML-based request*” and that “*the request comprises at least one parent data document and one or more child data documents*” as recited in Claim 8.

Thus, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest each and every limitation recited in dependent Claim 8. For at least substantially similar reasons, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest each and every limitation recited in dependent Claims 22, 37, and 51. As a result, even if the Examiner maintains the rejections of the independent claims in spite of the above remarks, Applicants respectfully submit that dependent Claims 8, 22, 37, and 51 are plainly allowable over the proposed *Lau-Tilden* combination. Applicants respectfully request reconsideration and allowance of dependent Claims 8, 22, 37, and 51.

As yet another example, as the Examiner concedes, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest that “*the parent data document comprises a purchase order and the child data documents comprise line items of the purchase order*.” *Office Action*, page 5. The Examiner takes Official Notice “that a purchase order and lines [sic] items of a purchase order were well known in the art to incorporate the teaching of the well known knowledge to have the data documents to be a purchase order and line items of the purchase order because one would want to implement various types of documents to meet

the needs of different types of systems. *Office Action*, page 5. Applicants respectfully traverse this Official Notice, at least as applied against the limitations recited in Claim 9, which rely on and further define the limitations recited in Claims 1 and 8 on which Claim 9 depends. Even if purchase orders containing line items were well-known to those of ordinary skill in the art at the time of the invention, Applicants disagree with the Examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a system, as specifically recited in Claim 1, in which "*each operation is packaged in an XML-based request*" and "*the request comprises at least one parent data document and one or more child data documents*," as specifically recited in Claim 8, and in which "*the parent data document comprises a purchase order and the child data documents comprise line items of the purchase order*," as specifically recited in Claim 9. If the Examiner intends to rely on Official Notice as to this combination of limitations to reject Claim 9, Applicants respectfully request that the Examiner cite a reference or provide a signed affidavit in support of Examiner's position. *See* M.P.E.P. § 2144.03. The proposed *Lau-Tilden* combination, even when combined with information generally available to those of ordinary skill in the art at the time of the invention, fails to disclose, teach, or suggest that "*the parent data document comprises a purchase order and the child data documents comprise line items of the purchase order*" as recited in Claim 9.

Thus, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest each and every limitation recited in dependent Claim 9. For at least substantially similar reasons, the proposed *Lau-Tilden* combination fails to disclose, teach, or suggest each and every limitation recited in dependent Claims 23, 38, and 52. As a result, even if the Examiner maintains the rejections of the independent claims in spite of the above remarks, Applicants respectfully submit that dependent Claims 9, 23, 38, and 52 are plainly allowable over the proposed *Lau-Tilden* combination. Applicants respectfully request reconsideration and allowance of dependent Claims 9, 23, 38, and 52.

Conclusion

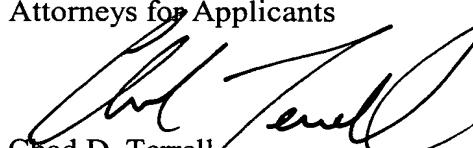
Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact the undersigned attorney for Applicants at the Examiner's convenience.

A check in the amount of \$110.00 is attached to cover the fee for a one month extension of time. Although Applicants believe no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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